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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,405	01/26/2001	Arthur W. Lauder	143-US	4701

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EXAMINER

SCHIFFMAN, JORI

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 10/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/769,405

Applicant(s)

LAUDER, ARTHUR W.

Examiner

Jori R. Schiffman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, and 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silva (US 4168393) in view of Bair (US 4668117).

Regarding claim 1, Silva discloses a rod coupling comprising a tubular housing 12 having a first end and a second end, the tubular housing having an interior surface 16 defining a bore extending along the tubular housing from the first box end to the second box end, the tubular housing having an exterior surface 48, plural openings 52 extending transversely through the housing from the interior surface to the exterior surface, and a coating 14 (col. 2, l. 52-53) on the exterior surface of the tubular housing and covering the plural openings. Silva fails to disclose the first and second ends being adapted for threaded connection. Bair teaches a rod coupling with first 12 and second 14 ends adapted for a threaded connection 13 so as to be able to receive a threaded pin 12a, 12b. It would have been obvious at the time the invention was made to a person of ordinary skill in the art to include threads on the first and second ends of Silva's housing as disclosed in Bair so the rod could be connected to a threaded fastener, such as a pin.

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Regarding claim 7, Silva as modified by Bair discloses the rod coupling as above except for a string formed of plural rods connected by plural rod couplings. Applicant is reminded that duplicating the components of a prior art device is a design consideration within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Accordingly, it would have been obvious at the time the invention was made to a person of ordinary skill in the art to duplicate the rod coupling of Silva as modified by Bair to form a string of plural rods connected by plural rod couplings.

As to claims 2 and 11, the coating 14 extends into the openings 52.

Regarding claims 4 and 8, Silva as modified by Bair discloses openings 52 that extend from the exterior surface of the housing to the interior surface. Silva as modified by Bair fails to disclose the openings tapering from the exterior surface towards the interior surface. Applicant is reminded that a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Accordingly, it would have been obvious at the time the invention was made to a person of ordinary skill in the art to add a taper to the openings in the housing of Silva as modified by Bair.

Referring to claims 5 and 9, the openings 52 are distributed uniformly around the tubular housing.

Regarding claims 6 and 10, the openings 52 are distributed in plural rows.

3. Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silva (US 4168393) in view of Bair (US 4668117) as applied to claims 1 and 7 above, and further in view of Edge (US 272033).

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Regarding claims 3 and 12, Silva as modified by Bair discloses the rod coupling as above except for the coating extending through the openings to form knobs inside the tubular housing. However, the formation of knobs would occur naturally since there is not anything to prevent the coating from extending into the bore, as discussed by Edge (lines 41-45). Therefore, it would have been obvious at the time the invention was made to a person of ordinary skill in the art for the coating on the housing of Silva as modified by Bair to form knobs when it extends through the openings.

Response to Arguments

4. Applicant's arguments with respect to claims 1, 2, 5, and 6 are moot in view of the new grounds of rejection, as claims 1-12 are now rejected under section 103. However, it is noted that applicant argued in response to rejections based on 102 that Silva is non-analogous art. Applicant is reminded that "arguments that the alleged anticipatory prior art is non-analogous art' or teaches away from the invention' or is not recognized as solving the problem solved by the claimed invention, [are] not germane' to a rejection under section 102." *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting *In re Self*, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)). Further, applicant is reminded that according to U.S. practice, patentability relies primarily on structure over function. Therefore, the fact that applicant's invention is intended to be *used* in a different environment is not germane to the question of whether or not applicant's claimed *structure* is disclosed or made obvious by the prior art.

5. In response to applicant's argument for claims 3, 4, and 7-12 that Silva is non-analogous art, it is known that rod couplings and cable couplings are analogous, but even so, an argument

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for non-analogous art under section 103 applies only between the references used in the rejection, not to one reference compared to applicant's invention. Therefore, the examiner would like to point out that Silva and Edge are analogous because Edge teaches a process of bonding for a more secure connection between components, which is exactly the problem with which Silva is concerned (col. 5, l. 21-26). Further, in the new rejection, Silva and Bair are also analogous since they are both connectors with free ends for connecting to other components.

Conclusion

6. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jori R. Schiffman whose telephone number is 703-305-4805. The examiner can normally be reached on M-Th, and every other Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on 703-308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-3179.

Jori R. Schiffman
Examiner
Art Unit 3679

JS
October 22, 2002


Lynne H. Browne
Supervisory Patent Examiner
Technology Center 3679